

REMARKS

Claims 32-39, 42-46, 52-56 and 59-79 are pending in this application. Claim 71 has been amended to simply correct the dependency of this claim. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Prosecution History/Issuance of Non-Enablement Rejection

On April 18, 2007, in a fifth Office Action and more than 2 years after the issuance of a first Office Action, for the first time the Examiner rejects all of the claims, based solely upon 35 USC §112, first paragraph, now asserting that all of the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicants point out that, despite the Examiners ability to understand the invention during the first four Office Actions, the assertion of lack of enablement is clearly misplaced and reconsideration is requested based upon the comments made herein. Furthermore, this assertion made for the first time in a fifth Office Action is clearly in contrast to the protocol recited in the Manual of Patent Examining Procedure (MPEP), issued by the US Patent and trademark Office, which directs the Examiner to present any issues of enablement at the earliest point possible, preferably in a first Office Action.

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In accordance with the principles of compact prosecution, if an enablement rejection is appropriate, the first Office action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal.

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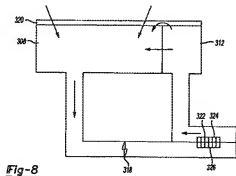
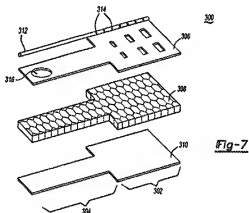
In other words, the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application. MPEP §2164.04 (emphasis added is by the USPTO and not the applicant).

Amendment to Specification

Applicants have amended paragraph 67 to recite that Figure 7 illustrates that the conduit may be located above the flow control layer. No new matter has been entered with this amendment.

Drawing Objections

The Drawings are objected to under 37 CFR §1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner asserts that the drawings fail to show "how ambient air drawn through the flow control layer and temperature conditioned air drawn through the conduit and [sic] mixed within the insert". The Examiner also asserts MPEP §608.02(d) indicating that any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. Applicants respectfully disagree that these standards have not been met. For reference, Applicants have reproduced Figs. 7 and 8 below.



As shown above, Fig. 7 illustrates an exploded perspective view of potential components of a fourth exemplary embodiment of an insert of the present invention. Figure 8 illustrates a schematic view of the insert shown in Fig. 7 demonstrating airflow through the system. As shown in Fig. 7, the insert 300 includes a spacer 308 located between a flow control layer 306 and fluid barrier 310. As described in the general description of the present invention, the flow control layer is preferably at least partially impermeable to fluids and particularly to air, except at a plurality of through holes. See Specification, paragraph 25. The plurality of holes formed in the flow control layer are shown in Fig. 7. Also, the insert is in fluid communications with a fan and a TED through port 316 formed in the flow control layer 306. See Specification, paragraph 69. Further, the spacer permits fluid flow through the material while also providing a measure of support for a seat occupant. See Specification, paragraph 20.

The insert also includes conduit 312 for providing fluid communications to or from the seat portion of the insert, via one or more flow holes 314. See Specification, paragraph 66. The conduit is in fluid communications with a fan 318 and TED 324. See Fig. 8 and Specification, paragraphs 70 and 72. The fan 318 pulls air through the spacer, and/or through an additional spacer 320, from the flow holes formed in the conduit. The fan provides motive force to move air (whether conditioned, ambient, pushed, pulled and combinations thereof) through the insert. See Specification, paragraph 36. Also, the Specification teaches that the insert is supported by a set cushion or backrest that may include one or more ducts that extend partially or completely through the cushion. See Specification, paragraph 18.

In view of the forgoing, as shown in Fig. 8 and described in the specification, the fan 318 draws ambient air through the plurality of through holes formed in the flow control layer 306 and temperature conditioned air through the one or more flow holes 314 of conduit 312. As shown, both the ambient air and the temperature conditioned air enter spacer 308 and inherently mix within the insert as they are drawn through port 316 by fan 318. Applicants are of the opinion that the combination of Figs. 7 and 8, in view of the corresponding description within the specification, fully teach and show how ambient air drawn through the flow control layer and temperature conditioned air drawn through the conduit are mixed within the insert. Furthermore, Applicants are of the opinion that there are not essential structural details absent

from the drawings shown in Figs. 7 and 8. The Examiner has yet to assert what essential structural details are absent.

For at least this reason, Applicants have traversed this objection to the drawings. Reconsideration of the drawings are requested.

The drawings are also objected to as failing to comply with 37 CFR §1.84(p)(4), wherein the Examiner asserts that reference character 312 has been used to designate the conduit however, figure 7 and 8 show two different conduits. Applicants respectfully disagree to this rejection.

Applicants point out that 37 CFR §1.84(p)(4) recites:

The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

The Examiner acknowledges that reference number 312 is used to show conduits in Figures 7 and 8, albeit different conduits. However, even if the Applicants were to acquiesce to the Examiner's assertions this is not in violation with 37 CFR §1.84(p)(4) because the reference number is not being used to designate different parts, but instead the same part, e.g. conduits. Furthermore, the Specification is clear in the Brief Description of the Drawings that Fig. 8 represents a schematic view of the fourth embodiment, which may include any of the conduits of the present invention.

For at least this reason, Applicants have traversed this objection to the drawings. Reconsideration of the drawings are requested.

Rejections under 35 USC §112

Claims 32-39, 42-46, 52-56 and 60-79 are rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement, which forbids claims containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, the Examiner asserts that the claim features of an insert comprising a flow control layer, a spacer, a fluid barrier, and a conduit through which ambient air is drawn and mixed with temperature

conditioned air in the insert is not supported so as to enable one skilled in the art how to make or use the invention without undue experimentation. By example, the Examiner asserts that in view of Fig. 7 it is not clear how the air from conduit 312 would mix in the insert as the apertures 314 appear to be outside of the insert area, above layer 306. Additionally, the Examiner asserts that it is not shown how this arrangement is provided on a seat. Applicants respectfully disagree.

The following are section from MPEP §2164.01 that relate to the current test for enablement:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

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Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988).

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Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 77 USPQ2d 1041 (Fed. Cir. 2005)

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With regards to enablement to make the claimed invention, MPEP §2164.01(b) provides:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)

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A key issue that can arise when determining whether the specification is enabling is whether the starting materials or apparatus necessary to make the invention are available. MPEP §2164.01(b).

With regards to enablement to to use the claimed invention, MPEP §2164.01(c) provides:

If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana*, 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993). MPEP §2164.01(c).

With regards to the Examiner assertions that it is not clear how the air from conduit 312 would mix in the insert as the apertures 314 appear to be outside of the insert area, above layer 306, Applicants point out that no wherein in Figure 7, or within the specification, is there a restriction on the exact placement or configuration of the conduit. Figure 7 illustrates an exploded perspective view of potential components that may be used to form an insert of the present invention. Nowhere in Figure 7 is there a limitation or requirement on the conduit being placed over the flow control layer. To the contrary, the specification is clear that the conduit may be placed in a number of locations (as currently amended herein) (emphasis added):

[0067] The conduit comprises one or more flow holes 314 located on the seat portion of the conduit. The flow holes may have one or more directions, i.e. generally normal to the place of the insert, generally in the same plane as the plane of the insert, or any angle in between. The conduit may be held within the insert (whether the insert is a sealed bag insert or not), attached to the exterior of the insert or formed as part of the insert. In a preferred embodiment, the conduit is located underneath the flow control layer and in the plane of the insert. As seen in the FIG. 7, the conduit may be located above the flow control layer.

[0072] Depending on the location of the conduit and the flow holes, the temperature conditioned air may flow directly to or from the conduit to the spacer. Alternately, the air may flow through another material between the conduit and the spacer. In this way, the temperature conditioned air is pulled (and/or pushed) across the

surface of the insert. For example, the air may flow through or over any of the optional layers discussed above such as an additional spacer (e.g. reticulated foam) or a covering (e.g. perforated leather).

The Examiner interpretation of Fig. 7, that the apertures 314 appear to be outside of the insert area and above layer 306 and therefore cannot communicate with the spacer is simply in contrast to the teachings of the present invention as discussed herein and within the specification.

With regards to the Examiner's assertion that it is not shown how the insert arrangement is provided on a seat, Applicants references the Background of the Invention pertaining to ventilated vehicle seats, which references numerous arrangement of ventilated seat. More so, Applicants reference the Specification of the present invention which is more than clear how the insert may be arranged onto or provided with a seat. Applicants have reproduced paragraphs 16-18 and 84-86 of the Specification of the present invention (emphasis added).

[0016] The present invention includes an insert suitable for placement within or on a seat to provide heating, cooling, ventilation or a combination thereof to a seat occupant. The insert will include at least one layer, but preferably includes multiple (e.g. three) layers and each of the layers may be a monolayer or a plurality of layers (e.g. a laminate). The plurality of layers need not be attached to each other but preferably are. More preferably, the layers are attached to each other at least at their edges to form an edge-sealed bag. The layers of the insert are typically co-extensive, although partial layers that are not co-extensive with the other layers or the insert may be suitable in certain instances.

[0017] The insert and the layers that make up the insert typically have a seat portion and an extension. As the name suggests, the seat portion generally is the area of the insert that will provide heating, cooling, ventilation or combinations thereof to the area of the seat where the seat occupant resides. The extension permits components of a system including the insert to be remote from the seat portion. This allows the components to be conveniently located so that they do not interfere with the comfort of the seat. While typically the extension is located at the back of the seat, it may be located on either side, in the front of the seat or absent altogether. Multiple extensions may also be used on an insert.

[0018] Typically, the insert is supported by a seat cushion or backrest cushion. The seat cushion or backrest cushion may include one or more ducts that extend partially or completely through the cushion, or the cushions may be free of ducts that extend through the cushion. A preferred cushion is a molded plastic foam, which is preferably free of a molded or cut-out fluid distribution ducting network, but may be adapted with a trench or opening for passing the extension from one side of the cushion to the another side. The seat cushion and/or backrest cushion may in turn be supported by a seat frame. Multiple inserts may be used on a single seat or backrest cushion, where inserts may accomplish the same or different functions (e.g. one insert may only cool, while another insert may both heat and cool).

[0084] For assembly of the insert or system to a seat, the insert is preferably secured (e.g., sewn, adhered or otherwise attached) to a portion of the seat such as the cover (e.g., a perforated leather cover) or to a seat or backrest cushion (e.g., foam) of the seat. In one embodiment, the insert is first secured to a seat cover and then the seat cover is secured to the seat. For example, the insert may be joined to seat cover at the edges of the insert or it may be joined to the seat cover at locations other than along the edges of the insert.

[0085] In another embodiment, a seat cover may be configured to include a pocket for receiving the insert. Alternatively, it is contemplated that hook and loop fasteners may be utilized to attach the insert to portions (e.g., the cover, frame, seat cushion or backrest cushion) of the seat. Other techniques may be used to assemble the insert to the seat such as sewing, adhesives, snap-fit fasteners or locating pins. Furthermore, the insert may be attached to other components of the seat such as the seat frame.

[0086] By packaging the components of the system substantially entirely within a seat of the present invention, rather than external thereof, it is possible to realize various advantages, such as ease of manufacturing and assembly. For example, it is possible to assemble all of the functional components at a remote assembly site, and thereafter transport a seat to an automotive assembly line, where the seat is merely mounted to the body in white and connected to the vehicle electrical system. In contrast, other systems might rely upon a cooling device that is located external of a seat to provide cooled air to the seat. Though such systems are within the scope of certain embodiments of the present invention, they are less preferred.

Applicants are of the opinion that the forgoing examples, along with other portions of the specification, more than adequately demonstrates how the insert of the present invention may be arranged onto or with a seat.

For at least these reasons, Applicants believe that the present invention, as claimed is fully supported by the specification and there exist no undue experimentation to make and use the invention. Accordingly, Applicants believe that the rejections to claims 32-39, 42-46, 52-56 and 60-79 are traversed and the claims are now in condition for allowance.

Request for Interview

In the interest in expediting prosecution, should the Examiner have any further concerns regarding enablement, Applicants explicitly request an Interview with the Examiner to discuss this issue.

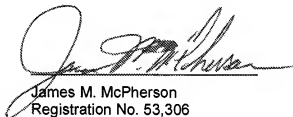
CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered traversed. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (319) 594-2200.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-1097 for any fee which may be due.

Date:

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